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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,933	03/07/2001	Brett C. Bookser	030727.0042.CIP1	3455
36183	7590	05/27/2004	EXAMINER	
PAUL, HASTINGS, JANOFSKY & WALKER LLP			MCKENZIE, THOMAS C	
P.O. BOX 919092			ART UNIT	
SAN DIEGO, CA 92191-9092			PAPER NUMBER	

1624

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/801,933

Applicant(s)

BOOKSER ET AL.

Examiner

Thomas McKenzie, Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,8-35 and 37-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,8-17,19,26,30,35,37-52,54,61 and 65 is/are rejected.
- 7) ☒ Claim(s) 18,20-25,27-29,31-34,53,55-60,62-64 and 66-70 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                                                        |                                                                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8,14&amp;12/18/03</u> . | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

1. This action is in response to amendments filed on 3/8/04/04. Applicant has amended claims 1, 9-12, 29, and 33-35. Applicant has canceled claims 3-7 and 36. Claims 37-70 are new. There are sixty-four claims pending and sixty-four under consideration. Claims 1, 2, 8-33, and 37-70 are compound claims. Claims 34 and 35 are use claims. This is the fourth action on the merits. The application concerns some phenyl phosphonate compounds and uses thereof.

***Response to Amendment***

2. Applicants' deletion of claim 7 renders moot the objection made in point #5 of the previous office action. Applicants have replaced the term "alicyclic" in claim 1 with the phrase "heterocyclic alkyl". That overcomes the indefiniteness rejection made in point #9 but raises issues of new matter and indefiniteness discussed below. Applicants' deletion of "prodrug" from the claims overcomes the indefiniteness rejection made in point #10, the enablement rejections made in points #11 and #12, the written description rejection made in point #13, and the art rejections made in points #16, #18, and #19. Applicants' deletion of claim 36 renders moot the enablement rejection made in point #14. Applicants' deletion of the provisos overcomes the new matter rejection made in point #15.

Applicants' deletion of the alkyleneoxyalkylene group from the definition of L in claim 1 overcomes the anticipation rejection over Krecmerova (Collection of

Czechoslovak Chemical Communications) made in point #17. Applicants claim 37 does not allow J<sup>3</sup> or J<sup>5</sup> to be amino. Thus, claim 37 is novel over Krecmerova (Collection of Czechoslovak Chemical Communications). Similarly, claims 69 and 70 do not allow alkyleneoxyalkylene group in the definition of L. Applicants' deletion of phenyl from their claimed linking group L overcomes the anticipation rejection over Duffy (WO 2001089457 A2) made in point #20. Applicants' claim 37 does not allow J<sup>5</sup> to be halogen. Thus, claim 37 is novel over Duffy (WO 2001089457 A2). Similarly, claims 69 and 70 do not allow the phenyl group in the definition of L. Applicants' deletion of the alkyleneoxyalkylene group from the definition of L in claim 1 overcomes the anticipation rejection over Diel ('701) made in point #14 of the office action of 11/25/02. Applicants' claim 37 does not allow J<sup>3</sup> or J<sup>4</sup> to be nitro or substituted aryloxy. Thus, claim 37 is novel over Diel ('701). Similarly, claims 69 and 70 do not allow alkyleneoxyalkylene group in the definition of L.

***Election/Restrictions***

3. Objection remains to claims 1, 2, 8-29, and 31-35 and objection is newly made to claims 37-70 as containing non-elected subject matter. The claimed compounds, compositions, and methods that employ them present a variable core. Formula I(b) contains compounds drawn to the non-elected inventions with X other than carbon. Formula I(a) is drawn to other non-elected inventions.

Applicants' comments about removing the non-elected material after allowance are noted. .

***Title***

4. After the restriction, the title of the invention remains non-descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The Examiner suggests replacing the phrase "Novel Aryl" with "Phenyl Phosphonate".

Applicants remark that the word "Aryl" included the presently claimed phenyl compounds. That is true but it also includes naphthalene, anthracene, phenanthrene compounds *etc.* which are not presently claimed. That, in fact, is the Examiner's point.

***Claim Objections***

5. Claims 8 and 43 are objected to because of the following informalities: there is no period after the formula in each of these two claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 8-17, 19, 26, 30, 34, 35, 37-52, 54, 61, and 65 are newly rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

Art Unit: 1624

particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "heterocyclic alkyl" is found in claims 1 and 37. It is neither a recognized term of art nor defined in the specification. There is no such thing. Is it an alkyl substituted by a heterocycle, e.g. pyridyl-methyl? A cycloalkyl interrupted by a heteroatom, such as piperidinyl? A cycloalkyl substituted by a heteroatom, e.g. chlorocyclohexyl? Whatever choice is selected must be supported by the specification.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 8-17, 19, 26, 30, 34, 35, 37-52, 54, 61, and 65 are newly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "heterocyclic alkyl" was not contained in the specification when this case was filed.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

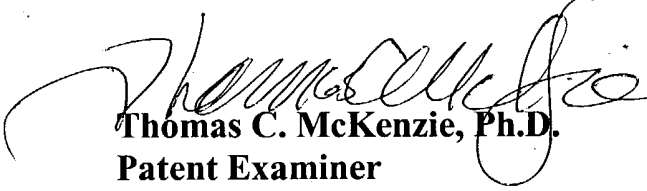
See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Information regarding the status of an application should be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). Please direct general inquiries to the receptionist whose telephone number is (703) 308-1235.

Application/Control Number: 09/801,933  
Art Unit: 1624

Page 7

10. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (571) 272-0670. The FAX number for amendments is (703) 872-9306. The PTO presently encourages all applicants to communicate by FAX. The Examiner is available from 8:30 to 5:30, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, please contact James O. Wilson, acting SPE of Art Unit 1624, at (571)-272-0661.

  
**Thomas C. McKenzie, Ph.D.**  
**Patent Examiner**  
**Art Unit 1624**

TCMcK/me